

## REMARKS

In accordance with the foregoing, claims 60 and 61 have been canceled. Claims 47-59 and 62-80 are pending, with claims 47, 52, 53, 55, 62, and 67 being independent. Claims 47-59 and 62-80 are directed to elected Invention I. No new matter is presented in this Amendment.

### Entry of Amendment After Final Rejection

In the Request for Continued Examination (RCE) of April 21, 2010, and on pages 1 and 12 of the Amendment Accompanying Request for Continued Examination of April 21, 2010, the applicant requested that the Amendment After Final Rejection of March 22, 2010, be entered.

However, the Office Action of August 20, 2010, does not indicate that the Amendment After Final Rejection of March 22, 2010, has been entered. Rather, page of the Office Action of August 20, 2010, merely states that "[t]his office action is in response to the Request for Continued Examination and the amendment filed on 21 April 2010, the Information Disclosure Statements filed on 10 February 2010 and 22 March 2010," without mentioning the Amendment After Final Rejection of March 22, 2010. Furthermore, nothing in the image file wrapper indicates that the Amendment After Final Rejection of March 22, 2010, has been entered.

Accordingly, it is respectfully requested that the Office confirm that the Amendment After Final Rejection of March 22, 2010, has been entered and considered.

### Information Disclosure Statement of February 10, 2010

On page 3 of the Office Action of August 20, 2010, the Office states that JP 11-161663 cited in the Information Disclosure Statement of February 10, 2010, has not been considered for the following reason:

Applicant submitted a copy of the reference JP 11-161663 to the Examiner and listed on the IDS to view 20030152366 or 2008159721 for a [sic] English transition [sic]. However neither of the US PGPubs submitted fail to list JP 11-161663 under the Foreign Application Priority Data in either of its front page. Thus, its [sic] unclear if 20030152366 or 2008159721 is an actual translation of the Japanese Application 11-161663 resulting in the IDS failing to comply with 1.98(a)(3)(ii).

However, JP 11-161663 is a publication number. The application number and application filing date of JP 11-161663 are JP 9-328595 and November 28, 1997, as indicated by INID Codes 21 and 22 on page 1 of JP 11-161663. See the definition of INID Codes 21 and 22 in MPEP 901.05(b) on MPEP page 900-17. The Foreign Application Priority Data on the front pages of US 2003/0152366 and US 20080159721 indicates that US 2003/0152366 and US 20080159721 claim the benefit of JP 9-328595 filed on November 28, 1997, as well as two other Japanese patent applications, such that US 2003/0152366 and US 20080159721 are in fact U.S. counterparts of JP 11-161663 as indicated in the Information Disclosure Statement of February 10, 2010. Accordingly, it is submitted that US 2003/0152366 and US 20080159721 should be considered as being actual English translations of JP 11-161663, thereby providing the concise explanation of the relevance of JP 11-161663 required by 37 CFR 1.98(a)(3)(i) pursuant to MPEP 609.04(a)(III) (see MPEP page 600-153, right column).

On page 3 of the Office Action of August 20, 2010, the Office states that the Japanese Office Action cited in the Information Disclosure Statement of February 10, 2010, has not been considered for the following reason:

[T]he Applicant submitted a Japanese Office Action; however, failed to provide a copy, or a portion, of the JP Office Action with an English-language translation. Thus, the IDS failed to comply with 1.98(a)(3)(ii).

However, 37 CFR 1.98(a)(3)(ii) states "[a] copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c)." Thus, 37 CFR 1.98(a)(3)(ii) does not require an applicant to prepare an English translation of a foreign Office Action. Furthermore, the Japan Patent Office does not provide English translations of Japanese Office Actions.

In any event, the relevance of the Japanese Office Action is that it cites JP 11-161663 as can be seen from page 3 of the Japanese Office Action. Accordingly, it is submitted that Japanese Office Action itself provides the concise statement of relevance required by 37 CFR 1.98(a)(3)(i). Alternatively, it is submitted that the preceding statement about the relevance of the Japanese Office Action provides the concise statement of relevance required by 37 CFR 1.98(a)(3)(i).

For at least the foregoing reasons, it is respectfully requested that JP 11-161663 and the Japanese Office Action cited in the Information Disclosure Statement of February 10, 2010, be considered.

Information Disclosure Statement Attached Hereto

Attached hereto is an Information Disclosure Statement listing the following references:

US 2002/0059603 A1

Japanese Office Action issued on November 10, 2009, in counterpart Japanese Application No. 2004-519334 (3 pages, in Japanese, no English translation).

US 2002/0059603 A1 was cited in the Information Disclosure Statement of February 13, 2004, and the Japanese Office Action issued on November 10, 2009, was cited in the Information Disclosure Statement of February 10, 2010, but there were errors in the listings of these references in those Information Disclosure Statements. Accordingly, corrected listings of these references have been provided in the Information Disclosure Statement attached hereto. Since the attached Information Disclosure Statement is being filed merely to correct errors in the listings of references that have already been cited in previous Information Disclosure Statements, it is submitted that neither a statement under 37 CFR 1.97(e) nor the fee set forth in 37 CFR 1.17(p) is required to file the Information Disclosure Statement attached hereto.

Furthermore, it is respectfully requested that the Office, provide with the next Office Action, a copy of the List of References Cited by Applicant from the Information Disclosure Statement of February 13, 2004, with a line drawn through the erroneous listing of US 2002/0059603 A1, and a copy of the Information Disclosure Statement of February 10, 2010, with a line drawn through the erroneous listing of the Japanese Office Action issued on November 10, 2009, to prevent these erroneous listings from being used in printing the "References Cited" section of any patent that may issue from the present application.

Claim Rejections Under 35 USC 112

Claims 60 and 61 have been rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the

applicants regard as the invention. This rejection is moot since claims 60 and 61 have been canceled in this Amendment.

Claim Rejections Under 35 USC 103

Claims 47-59 and 62-80 have been rejected under 35 USC 103(a) as being unpatentable over Lamkin et al. (Lamkin) (U.S. Patent Application Publication No. 2002/0088011) in view of Berstis et al. (Berstis) (U.S. Patent No. 6,510,458). The rejection of claims 60 and 61 is moot since claims 60 and 61 have been canceled in this Amendment. The rejection of claims 47-59 and 62-80 is respectfully traversed.

The Explanation of the Rejection Does Not Actually Address Claims 47-59 and 62-80

The explanation of the rejection of claims 47-59 and 62-80 under 35 USC 103(a) as being unpatentable over Lamkin in view of Berstis on pages 4-16 of the Office Action of August 20, 2010, is basically the same as the explanation of the rejection of claims 1-4, 20, 24, and 30-45 on pages 6-19 of the Final Office Action of January 21, 2010. In fact, the explanation of the rejection of claim 47 in the Office Action of August 20, 2010, is identical to the explanation of the rejection of claim 1 in the Final Office Action of January 21, 2010, even though there are substantial differences between claim 1, which reads as follows:

1. A data storage medium usable with a reproducing apparatus, comprising:
  - AV data; and
  - mark-up documents providing functionality enabling the reproducing apparatus to reproduce the AV data in an interactive mode;
  - wherein the mark-up documents comprise a start-up document comprising information about other ones of the mark-up documents corresponding to different parental levels to be displayed depending on a set parental level,

and claim 47, which reads as follows:

47. A data storage medium comprising:
  - audio/video (AV) data; and

mark-up documents to reproduce the AV data in an interactive mode by displaying the AV data on an AV screen embedded in a mark-up screen displaying interactive contents associated with the AV data when the mark-up documents are interpreted by a presentation engine of an apparatus to reproduce data in which the data storage medium is loaded;

wherein the mark-up documents comprise:

a plurality of mark-up documents corresponding to different parental levels; and

a start-up mark-up document specifying which one of the plurality of mark-up documents corresponding to different parental levels is to be interpreted by the presentation engine of the apparatus depending on a parental level set in the apparatus.

Accordingly, it is submitted that the explanation of the rejection of claims 47-59 and 62-80 under 35 USC 103(a) as being unpatentable over Lamkin in view of Berstis on pages 4-16 of the Office Action of August 20, 2010, is improper because it does not actually address claims 47-59 and 62-80, such that the Office has not established a *prima facie* case of obviousness with respect to claims 47-59 and 62-80.

Furthermore, should the Office repeat the rejection of claims 47-59 and 62-80 under 35 USC 103(a) as being unpatentable over Lamkin in view of Berstis in the next Office Action and provide a proper explanation of the rejection that actually addresses claims 47-59 and 62-80, it is submitted that the Office cannot make that Office Action final because doing so will deprive the applicants of the opportunity to respond to the proper explanation of the rejection in a response to a non-final Office Action that it would have had if the Office had provided the proper explanation of the rejection in the Office Action of August 20, 2010, as it should.

On October 27, 2010, the undersigned attorney, Randall S. Svihla, left voice mail messages for the Examiner, David Faber, and his supervisor, Supervisory Patent Examiner (SPE) Stephen Hong, pointing out the above issues.

On October 28, 2010, the Examiner left a voice mail message for the attorney stating that the attorney should put his comments in writing in the response to the Office Action of August 20, 2010, and the Examiner will consider them.

On October 28, 2010, the supervisor and the attorney discussed the issues by telephone. The attorney pointed out, for example, that the Examiner had not addressed the features recited in independent claims 47 and 55. The supervisor disagreed, stating that he considers claims 47

and 55 to recite basically the same features that were recited in canceled claim 1. The attorney stated that he disagreed with the supervisor because claims 47 and 55 are more specific than canceled claim 1. The attorney pointed out that the Examiner had not explained why Berstis would have motivated one of ordinary skill in the art to modify Lamkin to provide the features of claim 47 that are missing from Lamkin. The supervisor stated that he understood the attorney's concern that the Examiner had used the same explanation of the rejection of canceled claim 1 to reject claim 47 that is worded differently, and had not explained why Berstis would have motivated one of ordinary skill in the art to modify Lamkin to provide the features of claim 47 that are missing from Lamkin. The supervisor stated that the attorney should present arguments to that effect in the response to the Office Action of August 20, 2010, and that "the Office would do what is right."

#### Claim 47

It is submitted that Lamkin and Berstis do not disclose or suggest the following features of independent claim 47:

a plurality of mark-up documents corresponding to different parental levels; and

a start-up mark-up document specifying which one of the plurality of mark-up documents corresponding to different parental levels is to be interpreted by the presentation engine of the apparatus depending on a parental level set in the apparatus.

The Office did not even mention these features of claim 47 in the explanation of the rejection of claim 47 on pages 5 and 6 of the Office Action of August 20, 2010, such that the Office has not established a *prima facie* case of obviousness with respect to claim 47.

More specifically, the Office states "Lamkin et al [sic] discloses an [sic] method disclosing a DVD (a storage medium) containing AV data, and including HTML contents in directories to reproduce said AV data in an interactive mode." Thus, the Office apparently considers the ROM/HTML content 202 in FIG. 2 of Lamkin to comprise "a plurality of mark-up documents" as recited in claim 47. However, it is submitted that nothing whatsoever in Lamkin discloses or suggests that the ROM/HTML content 202 in FIG. 2 of Lamkin comprises "a plurality of mark-up documents corresponding to different parental levels" as recited in claim 47. Furthermore, the Office did not even mention this feature of claim 47 in explaining the rejection, such that the

Office has not established a *prima facie* case of obviousness with respect to this feature of claim 47.

The Office also states as follows:

In one embodiment, Lamkin teaches a common HTML page (index.htm) in a directory named "common" (a form of startup document) (Lamkin paragraph [0075]). Furthermore, Lamkin discloses various other embodiments in which a [sic] HTML page is shipped with a DVD (a form of startup document) that links to a web site on the Internet or other information (i.e. other documents is [sic] a form of other information) stored on the DVD (linking is a form of information about other markup document [sic]) (Lamkin, Paragraph 0035, 0066-0070) [sic]

Thus, the Office apparently considers the index.htm file in paragraph [0075] of Lamkin, or the screenplay in HTML format in paragraph [0066], or the HTML page shipped with the DVD in paragraphs [0068] and [0070] of Lamkin, to be "a start-up mark-up document" as recited in claim 47. However, it is submitted that none of these elements of Lamkin is "a start-up mark-up document specifying which one of the plurality of mark-up documents corresponding to different parental levels is to be interpreted by the presentation engine of the apparatus depending on a parental level set in the apparatus" as recited in claim 1. Furthermore, the Office did not even mention this feature of claim 47 in explaining the rejection, such that the Office has not established a *prima facie* case of obviousness with respect to this feature of claim 47.

The Office also states as follows:

Berstis teaches Web filtering of a web page whereby a user selectable ratings service (such as parental levels) is used to rate Web content, screening objectionable content, therefore blocking transmission, etc; [sic] based upon a numerical (value) level control, wherein these set predetermined value/ratings determine which elements, content and other information of the Web page to be displayed [sic].

Berstis discloses determining whether to cache an entire web page based on contents and attributes of the web page, and preferences set by a user, which may include the RSACI levels in FIG. 4 of Berstis, which the Office apparently considers to be "different parental levels" as recited in claim 47. It is submitted that nothing whatsoever in Berstis discloses or suggests "determin[ing] which elements, content and other information of the Web page to be displayed [sic]" as alleged by the Office.

Furthermore, it is submitted that nothing whatsoever in Berstis would have motivated one of ordinary skill in the art to modify the ROM/HTML content 202 in FIG. 2 of Lamkin to provide "a plurality of mark-up documents corresponding to different parental levels" as recited in claim 47, or to modify the index.htm file in paragraph [0075] of Lamkin, or the screenplay in HTML format in paragraph [0066] of Lamkin, or the HTML page shipped with the DVD in paragraphs [0068] and [0070] of Lamkin, to be "a start-up mark-up document specifying which one of the plurality of mark-up documents corresponding to different parental levels is to be interpreted by the presentation engine of the apparatus depending on a parental level set in the apparatus" as recited in claim 47. The Office has not even alleged that it would have been obvious to do this, and has not identified any reasons why one of ordinary skill in the art would have been motivated to do this, such that the Office has not established a *prima facie* case of obviousness with respect to these features of claim 47.

#### Claim 52

It is submitted that Lamkin and Berstis do not disclose or suggest the following features of independent claim 52:

wherein the interactive directory comprises a plurality of sub-directories corresponding to a plurality of different parental levels; and

wherein the mark-up documents comprise a plurality of mark-up documents corresponding to the plurality of different parental levels stored in corresponding ones of the plurality of sub-directories corresponding to the plurality of different parental levels.

On page 8 of the Office Action of August 20, 2010, the Office states "Lamkin teaches various directories (i.e. directories and subdirectories) storing both DVD content and HTML content accordingly (Lamkin paragraph [0035])." However, paragraph [0035] of Lamkin actually states "[t]he HTML content includes various directories that allow it to be accessed by multiple platforms of user devices." Thus, this paragraph of Lamkin actually appears to disclose a plurality of directories corresponding to a plurality of different user device platforms, rather than "a plurality of sub-directories corresponding to a plurality of different parental levels" as recited in claim 52. Nor is it seen how this feature can reasonably be considered to be taught by Berstis, which the Office considers to teach "Web filtering whereby a user selectable ratings service is



used to rate Web content against a multi-level (parental) rating systems(s) (i.e. [sic] MPAA, RSACi contain multi (different) level ratings), screening objectionable content, therefore blocking transmission."

Furthermore, since Lamkin and Berstis do not disclose or suggest "a plurality of sub-directories corresponding to a plurality of different parental levels" as recited in claim 52, it is submitted that Lamkin and Berstis necessarily do not disclose or suggest the feature "wherein the mark-up documents comprise a plurality of mark-up documents corresponding to the plurality of different parental levels stored in corresponding ones of the plurality of sub-directories corresponding to the plurality of different parental levels."

#### Claim 53

It is submitted that Lamkin and Berstis do not disclose or suggest the following features of independent claim 53 for at least the same reasons discussed above that Lamkin and Berstis do not disclose or suggest the same features of claim 52:

wherein the interactive directory comprises a plurality of sub-directories corresponding to a plurality of different parental levels; and

wherein the mark-up documents comprise:

a plurality of mark-up documents corresponding to the plurality of different parental levels stored in corresponding ones of the plurality of sub-directories corresponding to the plurality of different parental levels.

Furthermore, it is submitted that Lamkin and Berstis do not disclose or suggest the following feature of claim 53:

a start-up mark-up document comprising link information identifying locations of the plurality of mark-up documents corresponding to the plurality of different parental levels.

On page 10 of the Office Action of August 20, 2010, the Office states "[a]s per independent claim 53, Claim 53 recites similar limitations as in Claims 47 and 52 and is similarly rejected under rationale [sic]." However, claims 47 and 52 do not recite "a start-up mark-up document comprising link information identifying locations of the plurality of mark-up documents corresponding to the plurality of different parental levels" as recited in claim 53.

In the explanation of the rejection of claim 47 on pages 5 and 6 of the Office Action of August 20, 2010, and the explanation of the rejection of claim 52 on pages 8 and 9 of the Office Action of August 20, 2010, the Office states as follows:

Lamkin discloses various other embodiments in which a [sic] HTML page is shipped with a DVD (a form of startup document) that links to a web site on the Internet or other information (i.e. other documents is a form of other information) stored on the DVD (linking is a form of information about other markup document) (Lamkin, Paragraph 0035, 0066-0070)

However, it is submitted that nothing whatsoever in paragraphs [0035] and [0066]-[0070] of Lamkin discloses or suggests that the HTML page that is shipped with the DVD comprises "link information identifying locations of the plurality of mark-up documents corresponding to the plurality of different parental levels" recited in claim 53. Furthermore, the Office has not explained why it considers this feature of claim 53 to be disclosed or suggested by these portions of Lamkin, or any other portion of Lamkin, or any portion of Berstis, such that the Office has not established a *prima facie* case of obviousness with respect to this feature of claim 53.

#### Claim 55

It is submitted that Lamkin and Berstis do not disclose or suggest the following feature of independent claim 55:

wherein the mark-up documents comprise a mark-up document comprising, or linked to, display rule information for a plurality of different parental levels specifying whether to display the interactive contents associated with the AV data depending on a parental level set in the apparatus.

On page 10 of the Office Action of August 20, 2010, the Office states "[a]s per dependent [sic] claim 55, Claim 55 recites similar limitations as in Claims 47 and 52 and is similarly rejected under rationale [sic]." However, claim 55 is an independent claim, not a dependent claim as alleged by the Office. Furthermore, claims 47 and 52 do not recite the feature "wherein the mark-up documents comprise a mark-up document comprising, or linked to, display rule information for a plurality of different parental levels specifying whether to display the interactive contents associated with the AV data depending on a parental level set in the apparatus" recited in claim 55. Furthermore, the Office did not even mention this feature of claim 55 in the

explanation of the rejection of claims 47 and 52 on pages 5-6 and 8-9 of the Office Action of August 20, 2010, such that the Office has not established a *prima facie* case of obviousness with respect to claim 55.

In particular, the Office has not identified the element(s) in Lamkin and/or Berstis that it considers to correspond to the "display rule information" recited in claim 55. Column 12, lines 13-18, of Berstis discloses Platform for Internet Content Selection (PICS) labels that may contain content ratings, such as the RSACi ratings of 0 to 4 for violence, nudity, sex, and language as shown in FIG. 4 of Berstis. Column 15, lines 3-7, of Berstis discloses that these PICS labels may be embedded in HTML documents, although this is cumbersome. However, it is submitted that these PICS labels cannot reasonably be considered to "display rule information for a plurality of different parental levels" as recited in claim 55 because the PICS label merely indicates the parental level of the HTML document. Whether or not a particular HTML document is cached depends on the preferences set by the user as shown in FIGS. 11 and 12 of Berstis, which are not embedded in the HTML document. Furthermore, the Office has not explained why it considers Berstis to disclose or suggest this feature of claim 55, such that the Office has not established a *prima facie* case of obviousness with respect to this feature of claim 55.

#### Claim 62

It is submitted that Lamkin and Berstis do not disclose or suggest the following features of independent claim 62:

An apparatus to reproduce data recorded on a data storage medium, the data comprising audio/video (AV) data, and mark-up documents to reproduce the AV data in an interactive mode, the mark-up documents comprising a mark-up document comprising display rule information for a plurality of different parental levels, the apparatus comprising:

an optical pickup to radiate laser beams on the data storage medium to read the mark-up documents and the AV data from the data storage medium;

an AV decoder to decode the AV data read by the optical pickup to reproduce the AV data;

a presentation engine to interpret the mark-up documents read by the optical pickup to generate a mark-up screen having an AV screen embedded therein; and

a blender to blend the mark-up screen generated by the presentation engine and the AV data reproduced by the decoder so that the reproduced AV data is displayed on the AV screen embedded in the mark-up screen;

wherein the presentation engine:

identifies a value of a predetermined attribute of an element of one of the mark-up documents; and

determines whether to display the element on the mark-up screen depending on the value of the predetermined attribute, the display rule information, and a parental level set in the apparatus.

On page 12 of the Office Action of August 20, 2010, the Office states "[a]s per independent claim 62, Claim 62 recites similar limitations as in Claims 47 and 52 and is similarly rejected under rationale [sic]." However, claims 47 and 52 do not recite the features of claim 62 that are underlined above.

On pages 12 and 13 of the Office Action of August 20, 2010, the Office states as follows:

Lamkin discloses identifying parental level values (page 11, Right Column, ParentalLevelSelect(n)" command); however, fail [sic] to specifically disclose a presentation engine identifying a predetermined element of the mark-up document and determining whether to display the element depending on the predetermined value, parental level and display rule information. However, Berstis teaches Web filtering of a web page whereby a user selectable ratings service (such as parental levels) is used to rate Web content, screening objectionable content, therefore blocking transmission, etc [sic] wherein these set predetermined values determine which elements, content and other information of the Web page to be displayed.

With respect to the Office's statement that "Lamkin discloses identifying parental level values (page 11, Right Column, 'ParentalLevelSelect(n)' command)," it is noted that page 11, right column, referred to by the Office states that the ParentalLevelSelect(n) command "[s]elects parental level of player." Accordingly, it is submitted that Lamkin's "ParentalLevelSelect(n)" command does not "identify[] parental level values" alleged by the Office.

With respect the Office's statement that Lamkin . . . fail [sic] to specifically disclose a presentation engine identifying a predetermined element of the mark-up document and determining whether to display the element depending on the predetermined value, parental

level and display rule information," it is submitted that Lamkin also does not implicitly or inherently disclose these features of claim 62, and does not suggest these features of claim 62.

Although the Office considers Berstis to teach the features "wherein the presentation engine: identifies a value of a predetermined attribute of an element of one of the mark-up documents; and determines whether to display the element on the mark-up screen depending on the value of the predetermined attribute, the display rule information, and a parental level set in the apparatus" recited in claim 62, it is not seen where Berstis discloses or suggests "display rule information" as recited in claim 62, or "a mark-up document comprising display rule information for a plurality of different parental levels" as recited in claim 62.

Column 12, lines 13-18, of Berstis discloses Platform for Internet Content Selection (PICS) labels that may contain content ratings, such as the RSACi ratings of 0 to 4 for violence, nudity, sex, and language as shown in FIG. 4 of Berstis. Column 15, lines 3-7, of Berstis discloses that these PICS labels may be embedded in HTML documents, although this is cumbersome. However, it is submitted that these PICS labels cannot reasonably be considered to "display rule information for a plurality of different parental levels" as recited in claim 62 because the PICS label merely indicates the parental level of the HTML document. Whether or not a particular HTML document is cached depends on the preferences set by the user as shown in FIGS. 11 and 12 of Berstis, which are not embedded in the HTML document. Furthermore, the Office has not explained why it considers Berstis to disclose or suggest this feature of claim 62, such that the Office has not established a *prima facie* case of obviousness with respect to this feature of claim 62.

Furthermore, Berstis discloses determining whether to cache an entire web page based on contents and attributes of the web page, and the preferences set by the user. However, it is submitted that nothing whatsoever in Berstis discloses or suggests "determin[ing] whether to display the element [of one of the mark-up documents] on the mark-up screen depending on the value of the predetermined attribute, the display rule information, and a parental level set in the apparatus" as recited in claim 62. Furthermore, the Office has not explained why it considers Berstis to disclose or suggest the "determin[ing] whether to display the element" of claim 62, such that the Office has not established a *prima facie* case of obviousness with respect to this feature of claim 62.

Claim 67

It is submitted that Lamkin and Berstis do not disclose or suggest the following features of independent claim 67:

An apparatus to reproduce data from a data storage medium,  
the data comprising  
audio/video (AV) data, and  
mark-up documents to reproduce the AV data in an interactive mode by displaying the AV data on an AV screen embedded in a mark-up screen displaying interactive contents associated with the AV data,  
the mark-up documents comprising a mark-up document comprising instructions corresponding to different parental levels to control display of the interactive contents associated with the AV data depending on a parental level set in the apparatus,  
the apparatus comprising:  
an optical pickup to radiate laser beams on the data storage medium to read the mark-up documents and the AV data from the data storage medium; and  
a presentation engine to interpret the mark-up document comprising the instructions corresponding to the different parental levels in the mark-up documents read by the optical pickup to determine whether to display the interactive contents associated with the AV data depending on the parental level set in the apparatus.

On page 14 of the Office Action of August 20, 2010, the Office states "[a]s per claims 67-68, Claim [sic] 67-68 recite similar limitations as in Claims 47, 55, and 52 and is similarly rejected under rationale [sic]." However, claims 47, 55, and 62 do not recite the features of claim 67 that are underlined above. Furthermore, the Office did not even mention these features of claim 67 in the explanation of the rejection of claims 47, 55, and 62 on pages 5-6, 10, and 12-13 of the Office Action of August 20, 2010, such that the Office has not established a *prima facie* case of obviousness with respect to these features of claim 67.

Furthermore, it is submitted that the PICS label that may be embedded in an HTML document as disclosed in Berstis as discussed above in connection with claims 55 and 62 cannot reasonably be considered to "instructions corresponding to different parental levels to control display of the interactive contents associated with the AV data depending on a parental

level set in the apparatus" as recited in claim 62 because the PICS label merely indicates the parental level of the HTML document. Whether or not a particular HTML document is cached depends on the preferences set by the user as shown in FIGS. 11 and 12 of Berstis, which are not embedded in the HTML document.

#### Conclusion—Claim Rejections Under 35 USC 103

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 47-59 and 62-80 (i.e., claims 47, 52, 53, 55, 62, and 67 discussed above and claims 48-51, 54, 56-59, 63-66, and 68-80 depending directly or indirectly from claims 47, 53, 55, 62, and 67) under 35 USC 103(a) as being unpatentable over Lamkin in view of Berstis be withdrawn.

#### Double Patenting Rejections

Claims 47, 52, 53, 55, 60, 62, and 67 have been rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 4-7 of U.S. Patent No. 7,493,552, which issued from Application No. 10/612,415, the parent application of the present continuation application. The rejection of claim 60 is moot since claim 60 has been canceled in this Amendment. This rejection of claims 47, 52, 53, 55, 62, and 67 is respectfully traversed.

However, the Office Action of June 22, 2010, did not include a Notice of References Cited (form PTO-892) listing U.S. Patent No. 7,493,552 as required by MPEP 707, which states as follows:

The list of references cited appears on a separate form, Notice of References Cited, PTO-892 (copy in MPEP § 707.05) attached to applicant's copies of the action.

Accordingly, it is respectfully requested that the Office provide, with the next Office Action, a PTO-892 listing U.S. Patent No. 7,493,552.

The Office states as follows:

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the same limitations, using varying

technology such that claims 47, 52, 53, 55, 60, 62, and 67 are generic to the claims 1, 4-7 of U.S. Patent 7,493,552. That is, claims 47, 52, 53, 55, 60, 62, and 67 are anticipated by claims 1, 4-7 of U.S. Patent 7,493,552 since claims 1, 4-7 of U.S. Patent 7,493,552 contains [sic] all the limitations of claims 47, 52, 53, 55, 60, 62, and 67 of Application No. 10/777900 [sic].

However, it is submitted that claims 1 and 4-7 of U.S. Patent No. 7,493,552 do not explicitly recite the following combination of features of independent claim 47:

mark-up documents to reproduce the AV data in an interactive mode by displaying the AV data on an AV screen embedded in a mark-up screen displaying interactive contents associated with the AV data when the mark-up documents are interpreted by a presentation engine of an apparatus to reproduce data in which the data storage medium is loaded;

wherein the mark-up documents comprise:

a plurality of mark-up documents corresponding to different parental levels; and

a start-up mark-up document specifying which one of the plurality of mark-up documents corresponding to different parental levels is to be interpreted by the presentation engine of the apparatus depending on a parental level set in the apparatus,

or the following combination of features of independent claim 52:

mark-up documents, stored in the interactive directory, to reproduce the AV data in an interactive mode by displaying the AV data on an AV screen embedded in a mark-up screen displaying interactive contents associated with the AV data when the mark-up documents are interpreted by a presentation engine of an apparatus to reproduce data in which the data storage medium is loaded;

wherein the interactive directory comprises a plurality of sub-directories corresponding to a plurality of different parental levels; and

wherein the mark-up documents comprise a plurality of mark-up documents corresponding to the plurality of different parental levels stored in corresponding ones of the plurality of sub-directories corresponding to the plurality of different parental levels,

or the following combination of features of independent claim 53:



mark-up documents, stored in the interactive directory, to reproduce the AV data in an interactive mode by displaying the AV data on an AV screen embedded in a mark-up screen displaying interactive contents associated with the AV data when the mark-up documents are interpreted by a presentation engine of an apparatus to reproduce data in which the data storage medium is loaded;

wherein the interactive directory comprises a plurality of sub-directories corresponding to a plurality of different parental levels; and

wherein the mark-up documents comprise:

a plurality of mark-up documents corresponding to the plurality of different parental levels stored in corresponding ones of the plurality of sub-directories corresponding to the plurality of different parental levels; and

a start-up mark-up document comprising link information identifying locations of the plurality of mark-up documents corresponding to the plurality of different parental levels,

or the following combination of features of independent claim 55:

mark-up documents to reproduce the AV data in an interactive mode by displaying the AV data on an AV screen embedded in a mark-up screen displaying interactive contents associated with the AV data when the mark-up documents are interpreted by a presentation engine of an apparatus in which the data storage medium is loaded;

wherein the mark-up documents comprise a mark-up document comprising, or linked to, display rule information for a plurality of different parental levels specifying whether to display the interactive contents associated with the AV data depending on a parental level set in the apparatus,

or the following combination of features of independent claim 62:

An apparatus to reproduce data recorded on a data storage medium, the data comprising audio/video (AV) data, and mark-up documents to reproduce the AV data in an interactive mode, the mark-up documents comprising a mark-up document comprising display rule information for a plurality of different parental levels, the apparatus comprising:

an optical pickup to radiate laser beams on the data storage medium to read the mark-up documents and the AV data from the data storage medium;

an AV decoder to decode the AV data read by the optical pickup to reproduce the AV data;

a presentation engine to interpret the mark-up documents read by the optical pickup to generate a mark-up screen having an AV screen embedded therein; and

a blender to blend the mark-up screen generated by the presentation engine and the AV data reproduced by the decoder so that the reproduced AV data is displayed on the AV screen embedded in the mark-up screen;

wherein the presentation engine:

identifies a value of a predetermined attribute of an element of one of the mark-up documents; and

determines whether to display the element on the mark-up screen depending on the value of the predetermined attribute, the display rule information, and a parental level set in the apparatus,

or the following feature of independent claim 67:

the mark-up documents comprising a mark-up document comprising instructions corresponding to different parental levels to control display of the interactive contents associated with the AV data depending on a parental level set in the apparatus.

Accordingly, it is submitted that claims 47, 52, 53, 55, 62, and 67 are not anticipated by claims 1 and 4-7 of U.S. Patent No. 7,493,552 as alleged by the Office.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 47, 52, 53, 55, 62, and 67 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 4-7 of U.S. Patent No. 7,493,552 be withdrawn.

### Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Office is requested to telephone the undersigned to attend to these matters.

Please charge any fees under 37 CFR 1.16 and 1.17 that may be required for this paper only to Deposit Account 50-5113 in the name of North Star Intellectual Property Law, PC.

However, for the reasons discussed on page 12 of this paper, the \$180.00 fee set forth in 37 CFR 1.17(p) for submission of an Information Disclosure Statement is not required for the Information Disclosure Statement attached to this paper.

Respectfully submitted,

Date: November 19, 2010

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